

Claims 1-7 are rejected.

Claims 8-15 are withdrawn.

This response is submitted in response to a final office action. It is submitted that the response places the instant application in a condition for allowance, or alternatively, in better form for appeal.

**REJECTION OF CLAIMS 1, 6, 7 UNDER 35 U.S.C. §103**

Claims 1, 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,012,693 to Enomoto et al. in view of Japanese Patent No. JP8026030 to Tomiyoshi or U.S. Patent No. 6,204,753 to Schenk et al.

The Applicants respectfully traverse the 35 U.S.C. §103(a) rejection of claims 1, 6 and 7.

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this

necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

The law is also clear that a claim in dependent form shall be construed to incorporate all the limitations of the claim to which it refers. 35 U.S.C. §112 ¶ 4.

Independent claim 1, as amended, is presented below:

1. (Amended) An exterior rear view mirror for a vehicle comprising a base for mounting on a vehicle body, a housing pivotally mounted on the base for angular movement about a first axis, a reflective member mounted in the housing, an electric motor having an output shaft selectively operable to cause angular movement of the housing about the first pivot axis at a first discrete speed and at a second discrete speed, and a controller adapted to control the electric motor so as to selectively drive the housing about the first axis either at the first speed or at the second speed which is faster than the first speed.



The Examiner correctly noted that Enomoto et al. fail to disclose that "the controller is adapted to control the electric motor in such a manner that the motor operates at a first discrete speed and at a second discrete speed."

Apparently, the Examiner cited Tomiyoshi and Schenk et al. to cure the deficiencies in the teachings of Enomoto et al. However, neither Tomiyoshi nor Schenk et al. suggest that the housing is driven at two separate and discrete speeds, as presently claimed.

Tomiyoshi merely discloses that the swing speed of the motor-driven mirror can be adjusted. There is no mention of "swing speeds" which would indicate more than one speed being possible at a given time. Tomiyoshi only mentions that the rotating speed of the motors (not the mirror) can be adjusted. Thus, one of ordinary skill in the art would interpret that to mean that the motors, and thus the mirror, can be adjusted to rotate either slowly or rapidly or somewhere in between based on the settings, but that does not mean both slowly and rapidly at a given time, as the instantly claimed invention recites. Either the mirror disclosed by Tomiyoshi will rotate slowly or quickly, but not selectively both.

Schenk et al. also does not suggest a two-speed mirror adjustment system, wherein both speeds are determined by the movement of an output shaft of a motor. Schenk et al. merely discloses that the "rapid actuator 12" is in actuality a compressed spring that does not appear to be actuated by an output shaft of a motor. Therefore, one of ordinary skill in the art would not look to Schenk et al. for guidance on a two-speed mirror adjustment system, wherein both of the speeds are determined by the movement of an output shaft from a motor.

Accordingly, the Applicants submit that none of the cited references, either alone or in combination, render independent claim 1 obvious. Furthermore, dependent claims 6 and 7, are likewise allowable.

#### **REJECTION OF CLAIMS 1-7 UNDER 35 U.S.C. §103**

Claims 1-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,953,167 to Valentino in view of Japanese Patent No. JP8026030 to Tomiyoshi or U.S. Patent No. 6,204,753 to Schenk et al.

The Applicants respectfully traverse the 35 U.S.C. §103(a) rejection of claims 1-

7.

Again, the Examiner correctly noted that like Valentine, like Enomoto et al., fails to disclose that "the controller is adapted to control the electric motor in such a manner that the motor operates at a first discrete speed and at a second discrete speed."

Apparently, the Examiner cited Tomiyoshi and Schenk et al. to cure the deficiencies in the teachings of Valentino. However, as previously noted, neither Tomiyoshi nor Schenk et al. suggest that the housing is driven at two separate and discrete speeds, as presently claimed.

Reiterating, Tomiyoshi merely discloses that the swing speed of the motor-driven mirror can be adjusted. There is no mention of "swing speeds" which would indicate more than one speed. Tomiyoshi only mentions that the rotating speed of the motors (not the mirror) can be adjusted. Thus, one of ordinary skill in the art would interpret that to mean that the motors and thus the mirror can be adjusted to rotate either slowly or rapidly or somewhere in between based on the settings, but that does not mean both slowly and rapidly, as the instantly claimed invention recites. Either the mirror disclosed by Tomiyoshi will rotate slowly or quickly, but not selectively both.

Likewise, as previously noted, Schenk et al. also does not suggest a two-speed mirror adjustment system, wherein both speeds are determined by the movement of an output shaft of a motor. Schenk et al. merely discloses that the "rapid actuator 12" is in actuality a compressed spring that does not appear to be actuated by an output shaft of a motor. Therefore, one of ordinary skill in the art would not look to Schenk et al. for guidance on a two-speed mirror adjustment system, wherein both of the speeds are determined by the movement of an output shaft from a motor.

Accordingly, the Applicants submit that none of the cited references, either alone or in combination, render independent claim 1 obvious. Furthermore, dependent claims 2-7, are likewise allowable.

### **CONCLUSION**

In view of the foregoing, the Applicants respectfully request reconsideration and reexamination of the Application. The Applicants respectfully submit that each item raised by the Examiner in the Office Action of October 24, 2002 has been successfully traversed, overcome or rendered moot by this response. The Applicants respectfully submit that each of the claims in this application is in condition for allowance and such allowance is earnestly solicited.


The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Please send all future correspondence relating to this application to Warn, Burgess & Hoffmann, P.C., P.O. Box 70098, Rochester Hills, MI 48307.

Respectfully submitted,

WARN, BURGESS & HOFFMANN, P.C.  
Attorneys for Applicant(s)

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By:   
Philip R. Warn  
Reg. No. 32,775  
Preston H. Smirman  
Reg. No. 35,365

P.O. Box 70098  
Rochester Hills, MI 48307  
(248) 364-4300

PRW/PHS/acw